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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------|-------------|----------------------|---------------------|------------------|
| 09-769,432     | 01/26/2001  | Tetsuo Masubuchi     | 0649-0771P          | 5407             |

2292 7590 05/20/2003

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| EXAMINER |
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SHORT, PATRICIA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1712

DATE MAILED: 05/20/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769432

Applicant(s)

Mosbacher et al.

Examiner

Skout

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on April 8, 2003
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6, 9 is/are rejected.
- ☒ Claim(s) 7, 8 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 Other \_\_\_\_\_

Office Action Summary

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This action is in response to the request for continued examination (RCE) filed on April 8, 2003. The amendment previously filed on February 14, 2003 under 37 CFR 1.116 has been entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Statz. The reference teaches thermoplastic elastomer compositions comprising a polyester elastomer, an olefin resin modified with an epoxy group and an olefin-based elastomer that is not vulcanized. See examples in tables V, VI, VIII, IX, X and XII. The language olefin-based thermoplastic elastomers does not distinguish over the ethylene/n-butylacrylate/methacrylic acid copolymer (copolymers A-D shown in Table B) used in the examples of the reference.

Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Imai. The reference teaches thermoplastic elastomer compositions that comprise hydrogenated block copolymer having a polybutadiene block and a block that can be a styrene/butadiene copolymer, a modified olefin having an epoxy

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group and a polyester elastomer. The composition optionally contains additional rubbery compound that can be an olefin based thermoplastic elastomer. See col. 19, line 7 through col. 20, line 26 and Example 30 in Table 6. Use of a hydrogenated block copolymer that contains styrene is anticipated by or would have been obvious over the teachings of the reference. Additionally, the olefin based thermoplastic elastomer encompasses the EPDM used in Example 30.

Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

P. Short

May 15, 2003

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**PATRICIA A. SHORT**  
**PRIMARY EXAMINER**

*Patricia A. Short*